



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/045,178

01/11/2002

Noriyuki Kasahara

0072601-000005

7589

26138

7590

06/03/2009

Joseph R. Baker, APC

Gavrilovich, Dodd & Lindsey LLP

4660 La Jolla Village Drive, Suite 750

San Diego, CA 92122

EXAMINER

POPA, ILEANA

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

06/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/045,178	Applicant(s) KASAHARA ET AL.	
	Examiner ILEANA POPA	Art Unit 1633	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires 6 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 26 May 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 41,43-45,49-51,56,58,59,61,63-73,75,78-82 and 87-121.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/Ileana Popa/
 Primary Examiner, Art Unit 1633

Continuation of 5.

Applicant's reply has overcome the following rejection(s): The rejection of claims 41, 43-45, 49-51, 56, 58, 59, 61, 63-73, 75, 78-82, 87-121 under 35 U.S.C. 112, first paragraph, as introducing new matter.

Continuation of 8.

The reference provided after the final rejection will not be entered because Applicant failed to provide a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented. It is noted that the instant rejections have been of record and Applicant could have provided the reference earlier.

Continuation of 11.

(1) Claims 41, 43-45, 49-51, 56, 58, 59, 61, 63-73, 75, 78-82, and 87-121 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22, 23, and 26-34 of copending Application No. 11/805,411 in view of both Yan et al. (Prostrate, 1997, 32: 129-139, of record) and Sobol et al. (U.S. patent No. 5,674,486).

Applicant requested that the obvious-type double patenting rejection be held in abeyance. Applicant's request is acknowledged, however, the rejection is maintained until a terminal disclaimer is filed or the claims are amended to obviate the rejection.

(2) Claims 41, 43-45, 49-51, 56, 61, 66, 70, 71, 75, 78-80, 87, 89, 91, 97-102, 105, 107, 109, 115-119, and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ram et al. (Cancer Research, 1993, 53: 83-88), in view of each Martuza et al. (U.S. Patent No. 5,585,096), Murakami et al. (Gene, 1997, 202: 23-29), and Sobol et al. (U.S. patent No. 5,674,486).

Claims 41, 43-45, 49-51, 56, 61, 66, 70, 71, 75, 78-80, 87, 89, 91, 97-102, 105, 107, 109, 115-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ram et al. taken with each Martuza et al., Murakami et al., and Sobol et al., in further view of Douar et al. (Gene Ther, 1996, 3: 789-796, Abstract).

Claims 41, 43-45, 49-51, 56, 58, 59, 61, 66, 70, 71, 73, 75, 78-80, 87-92, 97-102, 105-110, 115-119, and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ram et al. taken with each Martuza et al., Murakami et al., and Sobol et al., in further view of both Vile et al. (Virology, 1995, 214: 307-313) and Yan et al. (Prostrate, 1997, 32: 129-139).

Claims 41, 43-45, 49-51, 56, 58, 61, 63-73, 75, 78-82, 87-119, and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ram et al. taken with each Martuza et al., Murakami et al., and Sobol et al., in further view of both Kasahara et al. (Science, 1994, 266: 1373-1376) and Vile et al.

It is noted that Applicant's arguments are not new and were previously addressed.